

## **REMARKS/ARGUMENTS**

This paper is responsive to the Final Office Action (“FOA”) mailed December 8, 2009. Claims 61-73 and 80-90 were rejected and remain pending. Claims 89 and 90 are currently amended. Claims 74-79 were previously cancelled. All amendments are fully supported by the original disclosure, and no new matter is added. Reconsideration of the rejections is respectfully requested.

### **Claim Objections**

Claims 89-90 were objected to because of informality. More specifically, claims 89 and 90 were indicated as depending from claims 89 and 90, respectively. Applicants thank the Examiner for assuming dependence of the claims from claim 88 for the purposes of examination. To correct any informality in claims 89 and 90, both claims have been amended to depend from claim 88. In addition, the term “age categories” in claims 89 and 90 has been amended to “predetermined age categories” as recited in claim 88 in order to ensure clear antecedent basis for the term.

These amendments obviate the objections to claims 89 and 90. Entry of the amendments and withdrawal of the objection to the claims is respectfully requested.

### **Request for Withdrawal of Finality of Office Action**

“Under present practice, second or any subsequent actions on the merits shall be final, **except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement** filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).” MPEP 706.07(a) (emphasis added).

In the FOA mailed December 8, 2009, the Examiner introduced new ground(s) of rejection not necessitated by amendments to the claims or based on an IDS filing under the circumstances described. Specifically, the FOA relied on a new reference (Cannon *et al.*, US 7,103,154) in combination with previously-cited references (Keinonen, Tyroler, and Haaramo) in the rejections of independent claims 73 and 80. The Examiner conceded that new ground(s) of rejection were introduced, but stated that the new ground(s) of rejection

were necessitated by Applicants' amendment (pg. 13, Final Office Action). Applicants respectfully disagree.

In the previous Office Action ("OA"), it was conceded that Keinonen and Tyroler do not disclose "cause the touch-screen display to display information associated with one or more messages received from the first source in response to the selection, by a user, of the first virtual key, and to display information associated with one or more messages received from the second source in response to the selection, by the user, of the second virtual key" as recited in claim 73 (pg. 5, Office Action of May 11, 2009). Haaramo, which was cited for teaching this feature, was asserted as disclosing **listening** to a voice message associated with associated with one or more messages received from the first/second source in response to a selection by the user of the first/second virtual key (pg. 5, Office Action mailed May 11, 2009).

Applicants argued in their response to the OA that the voice messaging disclosure of Haaramo, even in combination with Keinonen and Tyroler, did not teach or suggest "causing a touch-screen to **display** information . . . " as recited in claim 73 (see pg. 12-13, Supplemental Amendment and Response filed October 9, 2009). In that response, Applicants also amended claim 73 to replace the term "source" with the term "contact [of a contact list stored on the mobile electronic communications device]." Additionally, Applicants introduced new independent claim 80, which recited features substantially similar to those of claim 73, and dependent claims 81-90 (Response filed August 10, 2009; Supplemental Amendment and Response filed October 9, 2009).

In the subsequent FOA, claim 73 was rejected as obvious over Keinonen, Tyroler, and Haaramo in combination with a newly-cited reference (Cannon). It was again conceded that Keinonen and Tyroler do not disclose "cause the touch-screen display to display information associated with one or more messages . . . ." (pg. 5, FOA). It was further conceded that "Keinonen and Tyroler and Haaramo do not disclose **display** the message instead of **play** the **voice** message" (pg. 5, FOA).

As best understood by Applicants, Cannon was newly asserted in the FOA to remedy the deficiencies of Haaramo with regard to the recitation "cause the touch-screen display to display information associated with one or more messages." However, this recitation was previously presented for examination in Applicants' Request for Continued Examination

filed March 26, 2009. Applicants also argued in a subsequent response that Keinonen, Tyroler and Haaramo failed to teach or suggest “cause the touch-screen display to display information associated with one or more messages” (pg. 12-13, Supplemental Amendment and Response filed October 9, 2009), and the FOA conceded this point. Thus, Cannon was newly cited in the FOA in response to Applicants’ arguments regarding the deficiencies of Haaramo, not in response to the most recent claim amendments.

For at least these reasons, the amendments to independent claim 73 and the introduction of claim 80 in Applicants’ response filed October 9, 2009 did not necessitate the new ground(s) of rejection. The finality of the rejections was therefore premature and improper. Applicants respectfully request withdrawal of the finality of the rejections.

### **Claim Rejections Under 35 USC § 103**

Claims 73, 62-63, 80 and 82 were rejected under 35 USC 103(a) over Keinonen *et al.* (US 6,959,207 B2) in view of Tyroler (US 6,320,941 B1) and Haaramo *et al.* (US 2006/0211411) and further in view of Cannon *et al.* (US 7,103,154).

Claims 61 and 81 were rejected under 35 USC 103(a) over the same combination of references as applied to claims 73 and 80 and further in view of McLaughlin *et al.* (US 4,975,694).

Claims 64-71 and 83-90 were rejected under 35 USC 103(a) over the same combination of references as applied to claims 73 and 80 and further in view of Williams *et al.* (US 6,753,842).

Claim 72 was rejected under 35 USC 103(a) as being unpatentable over the same combination of references as applied to claim 61 and further in view of Williams *et al.* (US 6,753,842).

Viewed properly as a whole, as required by law, claim 73 recites a novel mobile electronic communications device configured to illuminate a virtual key assigned to a single contact when a message is received from that contact, and to display information relevant to a message from that contact upon activation of that key. Claim 73 requires that at least two virtual keys of a touch-screen are assigned to two corresponding contacts of a single contact list stored on the device. The claimed device illuminates a virtual key of a touch-screen in

response to receipt of a message from a particular sender, allowing the user to see at a glance, that the user has received a message from that sender. If the user wishes to view information associated with a message from that sender, the user can display the information by activating the virtual key assigned to that sender.

Keinonen, Tyroler, Haaramo, and Cannon were cited in combination for teaching or the recitations of claim 73.

Keinonen was cited for teaching a transceiver, a touch-screen display, and a processor unit coupled to the transceiver and touch-screen display. But the FOA conceded that Keinonen does not disclose that the processor unit is configured to “cause a light unit to light a first virtual key . . .” or to “cause a light unit to light a second virtual key . . . as recited in claim 73 (pg. 3, FOA).

Tyroler does not teach those features, as discussed by Applicants in the previous response. On the contrary, Tyroler **teaches away** from the recitations of claim 73 (pg. 10-12, Supplemental Amendment and Response filed October 9, 2009). It is improper to combine references where the references teach away from their combination. MPEP 2145, citing *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). Thus, the combination of Keinonen and Tyroler is improper, and does not teach or suggest “cause a light unit to light a second virtual key . . . to indicate receipt of a message from a second contact **of said contact list**” as recited in claim 73 (pg. 10-12, Supplemental Amendment and Response filed October 9, 2009).

As conceded in the FOA, Keinonen and Tyroler do not disclose “causing the touch-screen display to display information associated with one or more messages received from the first contact in response to the selection, by a user, of the first virtual key, and to display information associated with one or more messages received from the second contact in response to the selection, by the user, of the second virtual key” (pg. 5, FOA). Haaramo was cited for teaching this feature.

Haaramo cannot remedy the deficiencies of Keinonen and Tyroler, as discussed in Applicants’ previous response (pg. 12-13, Supplemental Amendment and Response filed October 9, 2009). The cited passages of Haaramo refer to **voice** messages – they do not

teach or even suggest causing a touch-screen display to **display** information associated with one or more messages received from the first or second contact in response to the selection, by the user, of the first or second virtual key. Haaramo, like Keinonen and Tyroler, also does not teach or suggest that two contacts of a single contact list stored on the mobile device are associated with two different “virtual keys” (pg. 12-13, Supplemental Amendment and Response filed October 9, 2009). In fact, Haaramo discloses that the terminal “does not need to know the actual members of a particular group” (paragraph [0010]). Haaramo also does not teach virtual keys or a touch-screen display.

The FOA suggested further modification of Keinonen and Tyroler to display the group buttons of Haaramo on the touch screen disclosed by Keinonen. At most, the suggested modifications would result in a touch screen with the emulated LED’s of Tyroler, indicating priority of a received email message, and the emulated group buttons of Tyroler, indicating receipt of a voice message from any member of the group associated with an emulated group button. Therefore, Haaramo does not teach or suggest the recitations of amended claim 1, alone or in combination with Tyroler and Keinonen.

The FOA conceded that Keinonen and Tyroler and Haaramo “do not disclose **display** the message instead of **play** the **voice** message” (pg. 5, FOA).

Cannon cannot remedy the deficiencies of Keinonen, Tyroler and Haaramo. Cannon discloses a *non-mobile* digital telephone answering device (TAD) with a voice-to-text converter. The TAD is physically coupled to a telephone line, a computer, and a printer (Figs. 1 and 2). The user of a remote telephone leaves a voice message on the TAD, which converts the voice message to text and transmits the converted message to a remote destination address (e.g. an email address; see col. 3, line 65 to col. 4, line 13). The text message may be stored, prepared by text output device 706 for printing, displaying, or outputting to a computer file, “similar to the conventional voice messaging system 700 shown in Figure 8” (col. 5, lines 7-19). The TAD may also send the text message as an email using a conventional email program (col. 8, lines 1-20). To receive the email, the user logs onto an email account and downloads email from a mailbox on a mail server of the ISP (col. 8, lines 38-44).

Cannon does not disclose or suggest causing a touch-screen to display information associated with a received message from a contact **in response to selection of a virtual key associated with that contact**. Cannon merely discloses that the TAD unit includes a display device 218 that may be used to view information such as the date and time of voice mail receipt (col. 5, lines 41-48). And like Haaramo and Tyroler, Cannon does not teach or suggest virtual keys, a touch-screen, or a contact list stored on a mobile electronic communications device.

At a minimum, the cited combination of references fails to teach or suggest “cause the touch-screen display to **display information** associated with one or more messages” received from a first/second contact of a contact list stored on the mobile device **in response to the selection**, by a user, **of the first/second virtual key**. As conceded in the FOA, Keinonen and Tyroler do not teach this recitation. Haaramo merely teaches a voice messaging system, and as was conceded in the FOA, fails to teach the display of information as required in claim 73. Cannon also does not teach or even suggest display of information in response to selection of a virtual key associated with a contact as required in claim 73.

For the sake of argument, even if the disclosures could be said to suggest modifying the device of Keinonen to display emulated priority lights and group buttons on the touch-screen as suggested in the FOA (Applicants do not concede this), further modification of the device with the disclosure of Cannon would not teach or suggest the recitations of claim 73 for the following reasons.

First, if such a device were further modified to include the TAD display, no additional functionality would result. The TAD display does not display information in response to selection of a virtual key associated with a contact. Thus, if a received message is a voice message from a member of a group associated with an emulated group button, the emulated group button might be illuminated; at most, pressing the emulated group button would cause the received voice message to play. And if the received message is not a voice message, the emulated priority lights would (at most) indicate the priority of the message based on the three sender lists stored in the memory. Regardless of message type, selection of an emulated buttons or an emulated priority light would not cause information associated with the message to be **displayed**.

Second, even if such a device were further modified to include both the TAD display *and* the TAD voice-to-text conversion functionality, as the FOA appears to suggest, there is still no suggestion of any relationship between selection of an emulated group button or emulated priority light and the displaying of text associated with a message from a sender associated with the emulated group button. If an incoming voice message is converted into text by the TAD converter and is received by the device after the conversion, as Cannon teaches, any emulated group button associated with the sender **would not be illuminated**, because the message is not being received as a voice message. In this case, at most, the emulated priority lights would indicate the priority of an email message converted from a voice message, based on the comparison of sender information to the three sender priority lists stored in memory. And if the voice message is instead received by the device *before* conversion of the message to text, and a corresponding group button is illuminated to indicate that a voice message was received, there is no suggestion of any connection between selection of the emulated group button and the displaying of information associated with the subsequently converted message. Regardless of original message type, selection of emulated group buttons/priority lights would not cause information associated with the message to be **displayed**.

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention **as a whole** would have been obvious. MPEP 2141.02, citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). The purpose of Tyroler is to indicate receipt of a high, medium, or low priority email message without requiring the user to access his/her internet account through a computer or similar devices. Keinonen is directed to alerting a user that a communication partner has activated a data object associated with that user. Haaramo is directed to group-based voice messaging. Cannon is directed to remote voice-to-text message conversion. Applicants respectfully maintain that a person having ordinary skill in the art would not have found the claimed subject matter, **as a whole**, obvious in light of the combined references.

Finally, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. MPEP 2143.01, citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Cannon discloses a standalone digital answering machine configured to receive analog voice messages via a telephone line connected to the machine and to convert the voice message to text before sending the converted message to a destination address. As Applicants best understand the suggested combination, incorporation of the voice-to-text features of Cannon into the wireless mobile device of Keinonen would require substantial redesign of the device and would change the principle of operation of the invention disclosed by Keinonen.

For at least the above reasons, Applicants respectfully submit that claim 73 is allowable over Keinonen in view of Tyroler, Haaramo, and Cannon.

Claims 61-72 depend from claim 73, incorporating its recitations, and are therefore allowable by virtue of their dependence from an allowable base claim. As discussed in Applicants' previous response, McLaughlin and Williams do not remedy the deficiencies of Keinonen, Tyroler, Haaramo, and Cannon. Thus, for at least the same reasons, claims 61-72 are also allowable over the cited references.

Claim 80 recites features substantially similar to those of claim 73, and is therefore allowable over the cited combination for at least the same reasons.

Claims 81-90 depend from claim 80, incorporating its recitations, and are therefore allowable by virtue of their dependence from an allowable base claim. As discussed in Applicants' previous response, McLaughlin and Williams do not remedy the deficiencies of Keinonen, Tyroler, Haaramo, and Cannon. Thus, for at least the same reasons, claims 61-72 are also allowable over the cited references.

## **CONCLUSION**

In view of the foregoing amendments and remarks, Applicants believe the applicable rejections have been overcome and all claims remaining in the application are presently in condition for allowance. Accordingly, favorable consideration and a Notice of Allowance are earnestly solicited. The Examiner is invited to telephone the undersigned representative at (206) 622-1711 if the Examiner believes that an interview might be useful for any reason.

It is not believed that extensions of time are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a).

If the Examiner has any questions concerning the present paper, the Examiner is kindly requested to contact the undersigned at (206) 407-1542. If any fees are due in connection with filing this paper, the Commissioner is authorized to charge the Deposit Account of Schwabe, Williamson and Wyatt, P.C., No. 50-0393.

Respectfully submitted,  
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Date: February 8, 2010 By: /Jo Ann Schmidt/  
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